

REMARKS

Claims 1-4, 6, 8, 10-16, 19-21, 23-24, 26, 29-40, 43-53, 56-73, 76-97, 100-12, 114-125, and 128-138 are pending in the present application. Claims 5, 7, 9, 17-18, 22, 25, 27-28, 41-42, 54-55, 74-75, 98-99, 113, and 126-127 were previously canceled without prejudice or disclaimer. Claims 10-11, 34-35, 45-53, 56-73, 76-97, 100-111, 115-117, 129-130, and 134 have been withdrawn from consideration as being drawn to a non-elected invention.

Applicants thank the Examiner for withdrawing the rejection of claims 1-4, 6, 8, 12-13, 15-16, 19, 20-21, 23-24, 26, 29, 30-31, 36-37, 39-40, 43-44, 112-113, 118-125, 128, 131-132, 135-136, and 138 as being obvious over Di Schiena in view of Yu et al.

Claims 1, 3, 4, 20, 21, 24, 30, 112, 119 and 120 have been amended, for the sole reason of advancing prosecution. Applicants, by amending any claims herein and/or canceling any claims, make no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicants reserve the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application.

Specifically, claims 1, 21, 30, and 112 have been amended to delete the recited acids. Claims 1, 21 and 112 have been amended to recite "optionally one or more excipients selected from the group consisting of a vitamin, a preservative, a buffer, a stabilizer, a propellant, a hair generating agent, an antibacterial agent, a

refrigerant, an amino acid, an oil component, a perfume, an antioxidant, a UV absorber, a dye, a humectant, a thickener, a gelling agent, a perfume and a color additive." Support for these amendments appears throughout the specification and claims as originally filed. For example, please see the present specification at pages 4 and 5. No new matter has been added.

Claims 4 and 120 have been amended to delete the term "approximately." Support for these amendments appears throughout the specification and claims as originally filed. No new matter has been added.

Claims 1, 3, 4, 20, 21, 24, 30, 112, 119, and 120 have been amended to place them in proper U.S. format. No new matter has been added.

In view of the following, further and favorable consideration is respectfully requested.

- I. ***At page 3 of the final Official Action, the Examiner has maintained the rejection of claims 1-4, 6, 8, 12, 13, 15-16, 19-21, 23-24, 26, 29, 112, 114, 118-125, 128, 131-132, and 135-138 under 35 USC § 103 (a), as being unpatentable over Peck et al. in view of Weiner et al. or Yu et al., respectively.***

The Examiner asserts that "It would have been obvious to the skilled artisan to combine the teachings of Peck et al. and Weiner and utilize the instant minoxidil acid salt" because Weiner teaches that this addition yields a hydrophilic compound that allows for better penetration into the hair follicles."

Regarding Applicants previous arguments and the submitted rule 132 Declaration, the Examiner asserts that the arguments and Declaration are not

persuasive. The Examiner maintains her position that Weiner shows that the addition of an acid salt yields a hydrophilic compound and allows for better penetration into the hair follicles.

With regard to Yu et al., the Examiner asserts that Yu et al. teach that adding lactic acid dissolves minoxidil, providing better penetration of minoxidil.

Regarding Applicants previous arguments and the submitted rule 132 Declaration, the Examiner asserts that the arguments and Declaration are not persuasive. The Examiner maintains her position that Weiner shows that the addition of an acid salt yields a hydrophilic compound and allows for better penetration into the hair follicles.

With regard to claims 1 and 112, the Examiner also asserts that while the claims were amended to recite the transition language “consisting of,” they were also amended to optionally include one or more excipients that would allow for the inclusion of lipid vesicles which would be considered an excipient, i.e., a penetration agent.

In view of the following, this rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 (2007), “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to

interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

With regard to motivation to combine references, **MPEP 2143** discusses the requirements of a *prima facie* case of obviousness. First, there must be some suggestion or motivation to combine the reference teachings or to modify the reference, and second, there must be a reasonable expectation of success. Finally, the prior art reference or references when properly combined, must teach or suggest all the claim limitations.

Regarding motivation to modify properly combined references, **MPEP 2143.01** states that a proposed modification cannot render the prior art unsatisfactory for its intended purpose. If it does, then there is no suggestion or motivation to make the proposed modification. Further, the proposed modification cannot change the principle operation of a reference.

Regarding *teaching away*, **MPEP 2141.02** states that prior art must be considered in its entirety, including disclosures that *teach away* from the claims. See also **MPEP 2145(X)(D)**. The Federal Circuit in *Takeda v. Alphapharm* found that the prior art taught away from the closest compound because the prior art in fact disclosed a broad selection of compounds where the closest prior art compound exhibited negative properties that would have led the skilled artisan away from that compound.

In *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, Federal Circuit, No. 06-1325 (June 28, 2007), the Federal Circuit rejected Alphapharm's argument that the prior art would have led one of ordinary skill in the art to select compound b as a lead compound most promising to modify in order to improve its antidiabetic activity and thus potentially arrive at the claimed pioglitazone. The district court considered three references in reaching its determination, namely Takeda's '200 patent; Sodha II; and Takeda's '779 patent. The district court found that Sodha II taught away from compound b and that any suggestion in the '779 patent to select compound b was essentially negated by the disclosure of Sodha II in view of the more exhaustive

and reliable scientific analysis presented by Sodha II and the teaching away. Accordingly, the Federal Circuit accorded more weight to the Sodha II reference.

It is submitted that a *prima facie* case of obviousness has not been established because the Peck et al. and Weiner et al. references or the Peck and Yu et al. references fail to teach or suggest all of the limitations of the claims as required by *In re Wilson*. Further, a *prima facie* case of obviousness has not been established because the skilled artisan would have no motivation to modify Peck et al. to incorporate the acid salt of Weiner et al. since Weiner et al. teach away from a minoxidil acid salt.

Present claims 1, 21 and 112 have been amended to recite “optionally one or more excipients selected from the group consisting of a vitamin, a preservative, a buffer, a stabilizer, a propellant, a hair generating agent, an antibacterial agent, a refrigerant, an amino acid, an oil component, a perfume, an antioxidant, a UV absorber, a dye, a humectant, a thickener, a gelling agent, a perfume and a color additive.” More specifically, claims 1, 21 and 112 clearly exclude the inclusion of a lipid vesicle.

In addition, it is submitted that the skilled artisan would have no motivation to prepare a formulation by reacting minoxidil with an acid, absent encapsulation of the resultant minoxidil acid salt in a lipid vesicle, because Weiner et al. describe that an unencapsulated minoxidil salt formulation exhibits less than one-quarter the penetration exhibited by an encapsulated minoxidil acid salt formulation.

The Peck et al. and Weiner et al. references, or the Peck et al. and Yu et al. references, fail to teach or suggest all of the limitations of the claims as required by *In re Wilson*, because none of the foregoing references taken alone or together, teach or suggest a composition having **BOTH** at least 5% minoxidil or a pharmaceutically acceptable salt thereof **AND** less than 10% by weight polyhydric alcohol, as is presently claimed.

Peck et al. broadly describe at page 2, composition (1) that includes 1 to about 5% minoxidil and 10 to about 50% propylene glycol. Thereafter, Peck et al. describe specific formulations, for example, formulations (e) and (f) at page 4, that each include 50% propylene glycol and 5% minoxidil. Further, each of Examples 5 and 6 of Peck et al. describe preparing compositions including 5% minoxidil and 50% propylene glycol.

Peck et al. **teach away** from the presently claimed subject matter, because the formulations of Peck et al. that include a high concentration of minoxidil, i.e., 5%, also include high concentrations of propylene glycol, i.e., 50%. See formulations (e) and (f), and Examples 5 and 6, of Peck et al. Numerous other prior art formulations also teach away from the present invention by requiring high percentages of propylene glycol or a similar diol or triol to achieve high minoxidil concentrations, i.e. greater than 5% (see the present specification at page 1, lines 11-21). **Thus, no suggestion or motivation has been provided to modify Peck et al. to arrive at the composition as recited in the present claims.**

Moreover, all of the examples of Peck et al. have very **high levels** of propylene glycol or other diols and triols. This is conventional technology that uses high propylene glycol concentrations in order to load minoxidil into the formulation. In Example 1, where the propylene glycol amount is 20%, there is only 2% minoxidil in the formulation. In Example 2(a), where propylene glycol and butylene glycol are present in a combined amount of 40%, there is only 2% minoxidil. In Example 2 (b), where the butylene glycol amount is 15%, there is only 1% minoxidil. Likewise, in Examples 3 and 4, where the propylene glycol amount is 30%, there is only 2% minoxidil in the formulation. In Example 7, where propylene glycol and butylene glycol are present in a combined amount of 25%, there is only 2% minoxidil. Only in Examples 5 and 6 where the propylene glycol amount is 50%, is minoxidil present in an amount of 5% in the formulations. This does not teach or suggest an advantage of having **BOTH reduced levels** of the co-solvent such as less than 10% polyhydric alcohol and **high loading of minoxidil** such as at least 5%, as presently claimed. Accordingly, Peck et al. do not teach or suggest the presently claimed subject matter.

The foregoing remarks are further supported by the previously submitted Declaration (submitted with the Amendment and Response filed on November 8, 2007) under 37 CFR §1.132 by Barry Hunt ("the Hunt Declaration"). Barry Hunt is a formulation scientist of the assignee of the subject application and has been in pharmaceutical research since 1972. He has been employed doing formulation

research and development for the last 35 years.

In paragraphs 4-8, Mr. Hunt declares that he has reviewed Peck et al. and as exemplified therein, formulations having high loading of minoxidil are accompanied by high levels of polyhydric alcohols. In fact, in paragraph 8, Mr. Hunt sets forth that Peck et al. exemplify the following formulations:

- The composition of Example 5 contains 5% minoxidil and 50% propylene glycol.
- The composition of Example 6 contains 5% minoxidil and 50% propylene glycol.
- Compositions (e) and (f) each contain 5.0% minoxidil and 50.0% propylene glycol.
- The compositions of claims 13 and 14 each contain 5.0% minoxidil and 50.0% propylene glycol

Thus, Mr. Hunt declares in paragraph 8 that, similar to other compositions described in the prior art, the compositions exemplified in Peck et al. contain a very high percentage (i.e., 50%) of the polyhydric alcohol propylene glycol in order to improve the solubility of a high concentration (i.e. 5%) of minoxidil. Such high amounts of polyhydric alcohol are not pharmaceutically or cosmetically elegant, may be unacceptable to the consumer, and may cause local irritation and hypersensitivity upon application to the scalp (see paragraph 6 of the Hunt Declaration).

With regard to Weiner et al., Weiner et al. do not cure the deficiencies of Peck et al. because Weiner et al. also do not teach or suggest a composition having

BOTH at least 5% minoxidil or a pharmaceutically acceptable salt thereof **AND** less than 10% by weight polyhydric alcohol. Weiner et al. describe a formulation that requires minoxidil to be reacted with an acid or base and then be encapsulated into lipid vesicles. See page 4, lines 13-18.

Further, the skilled artisan would have no motivation to modify Peck et al. by utilizing the minoxidil acid salt of Weiner et al.

In this regard, the Examiner has asserted that Weiner et al. teach modifying the solubility of the active in an aqueous solution to make it more hydrophilic does not change the active agent's therapeutic properties, and that the modified active agent (that is more hydrophilic) has improved penetration through the hair follicle. Contrary to the Examiner's assertion, the data presented in Weiner et al. clearly illustrate that changing the solubility of minoxidil by reacting it with an acid renders the resultant formulation **essentially undeliverable** in the absence of encapsulation. Accordingly, not only does Weiner et al. illustrate that the resultant unencapsulated formulation does **not** exhibit improved penetration through the hair follicle, Weiner et al. clearly illustrate that it exhibits **extremely poor** penetration.

Specifically, the data presented in Example 3 of Weiner et al. shows that minoxidil reacted with lactic acid (formulation XI), but not encapsulated in a lipid vesicle, is essentially undeliverable into hairless rat skin. In contrast, the Weiner et al. data shows that a lipid vesicle encapsulated lactic acid-treated minoxidil (formulation III) penetrated living skin strata more deeply than the other tested

formulations. See formulations III and XI in Table 1, on page 6, in the "Living skin Strata" column, and page 7, lines 9-17.

As can be seen from Table 1 of Weiner et al., the percentage of the applied dose of encapsulated minoxidil salt formulation III that penetrated the living skin strata was 0.75 ± 0.33 while the percentage of unencapsulated minoxidil salt formulation XI that penetrated the living skin strata was 0.18 ± 0.01 . Applicants note Weiner et al. state at page 7, line 3, that "Formula XI is the same as Formula III except lacking the vesicles." This data clearly shows that encapsulated minoxidil lactic acid salt formulation III had more than four times the penetration into the deepest skin strata than that of unencapsulated minoxidil lactic acid salt formulation XI.

Further, contrary to the Examiners assertion, Weiner et al. attribute improved penetration of the encapsulated minoxidil formulation to the lipid vesicle and the particular lipid selected and *not* to the minoxidil acid salt. Specifically, Weiner et al. state at page 7, lines 15-17, that "[W]hat is most interesting is that a simple change from glycerol dilaurate (C12) to glycerol distearate (C18) in the vesicle wall changes the penetration several fold."

In view of the foregoing, the skilled artisan would have no motivation to prepare a formulation by reacting minoxidil with an acid, ***absent encapsulation*** of the resultant minoxidil acid salt in a lipid vesicle, because Weiner et al. describe that ***an unencapsulated minoxidil salt formulation exhibits less than one-quarter***

the penetration exhibited by an encapsulated minoxidil acid salt formulation.

Again, claims 1 and 112 recite the transition language “consisting of.” Claim 21 recites providing a pharmaceutical composition “consisting of.” This transition language excludes components other than those expressly recited. More specifically, claims 1, 21 and 112 which recite the transition language “consisting of” and optional specific excipients, clearly exclude encapsulation in lipid vesicles.

In addition, Weiner et al. **teach away** from preparing an unencapsulated minoxidil acid salt formulation, because the skilled artisan in view of the data in Example 3 would be led away from preparing and administering an unencapsulated minoxidil salt formulation. Specifically, Example 3 of Weiner et al. illustrates that commercial Rogaine® (formulation **XII**), which does not include a minoxidil salt, but includes minoxidil in a combination of ethanol, propylene glycol and water and is not encapsulated in a lipid vesicle, was second only to formulation **III** in efficacy (penetration of living skin strata). Again, Weiner et al. describe that the percentage of unencapsulated minoxidil salt formulation **XI** that penetrated the living skin strata was 0.18 ± 0.01 . The percentage of unencapsulated minoxidil formulation **XII** that penetrated the living skin strata was 0.35 ± 0.14 . This data clearly shows that unencapsulated minoxidil formulation **XII** had **twice** the penetration into the deepest skin strata than that of unencapsulated minoxidil lactic acid salt formulation **XI**. Thus, the skilled artisan in view of the data in Weiner et al., which shows that unencapsulated minoxidil formulation **XII** (commercial Rogaine®) exhibits

significantly greater penetration than unencapsulated minoxidil lactic acid salt formulation **XI**, would be *led away* from preparing an unencapsulated minoxidil salt formulation.

In view of the foregoing, the skilled artisan would have had no motivation to prepare a formulation employing a minoxidil salt or by reacting minoxidil with an acid to form a minoxidil salt. Weiner et al. illustrate that an unencapsulated minoxidil salt formulation exhibits only half the penetration exhibited by an unencapsulated minoxidil propylene glycol formulation (commercial Rogaine®) and thus **teaches away** from the present claims.

In further support of the above, Applicants submit that increasing solubility is not equivalent to increasing skin permeation. Please see pages 28-29 of *Skin Permeation, Fundamentals and Application*, Joel L. Zatz, PhD, submitted with the Amendment and Response filed on November 8, 2007. More specifically, page 29, lines 2-4, describe that "In every case studied, the permeability coefficient of the unionized form exceeds that of the charged species, in some cases by two or three orders of magnitude."

With regard to Yu et al., Yu et al. do not cure the deficiencies of Peck et al. because Yu et al also do not teach or suggest a composition having **BOTH** at least 5% minoxidil or a pharmaceutically acceptable salt thereof **AND** less than approximately 10% by weight polyhydric alcohol. Yu et al. is directed to the use of hydroxyacids to enhance the "therapeutic efficacy of cosmetic and pharmaceutical

agents." See col. 2, lines 16-21. In particular, Yu et al. describe the use of "hydroxycarboxylic acids and related compounds" as "enhancing compounds" to enhance the therapeutic efficacy of cosmetic and pharmaceutical agents in topical treatment of cosmetic conditions, dermatologic disorders, or other afflictions. See col. 2, lines 16-42.

Yu et al. is not concerned with and does not even remotely address the problem that the present invention solves, namely, increasing minoxidil amounts while minimizing amounts of propylene glycol, or other polyols. Yu et al. clearly do not describe or suggest the present composition which requires "at least 5% by weight, based on the total weight of the composition, of minoxidil or a pharmaceutically acceptable salt thereof," "an acid in an amount to substantially completely solubilize the minoxidil or a pharmaceutically acceptable salt thereof," and a co-solvent wherein when the co-solvent comprises one or more polyhydric alcohols, the one or more polyhydric alcohols are present in an amount of "less than 10% by weight."

Example 3 of Yu et al. describe a "2% minoxidil" formulation formed by dissolving 2 grams minoxidil and 3 ml lactic acid into a mixture of 80 ml ethanol and 15 ml propylene glycol. A 2% minoxidil formulation contains much less minoxidil than the present compositions which require at least 5% minoxidil. In addition, the formulation of Example 3 of Yu et al. has a large propylene glycol content, i.e., 15%, which amount is substantially greater than the presently claimed "less than 10% by

weight."

In addition, Applicants submit that any suggestion in Yu et al. to employ a minoxidil acid salt is negated by the disclosure of Weiner et al. in view of the more exhaustive and reliable scientific analysis presented by Weiner et al. and the teaching away from the present claims by Weiner et al. See *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, *Id.* The Examiner is respectfully requested to expressly address this argument should this rejection be maintained.

More specifically, Weiner et al. in Examples 1-3 and in Tables 1 and 2, at pages 4-8, provide extensive comparative penetration data with regard to various encapsulated and unencapsulated minoxidil formulations. Further, as discussed herein, Weiner et al. **teach away** from the use of an **unencapsulated minoxidil salt formulation**. On the other hand, Yu et al. provide **no data at all** with regard to minoxidil formulations. Only **prophetic** Example 3 of Yu et al. is directed to a composition containing a minoxidil acid salt. No data is provided. Accordingly, Weiner et al. is entitled to more weight than Yu et al. in accordance with *Takeda*. The Examiner is respectfully requested to expressly address these arguments if this rejection is to be maintained.

In view of the foregoing, it is submitted that nothing in Peck et al., Weiner et al., and Yu et al., taken alone or together, renders the claimed invention obvious within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection of pending claims 1-4, 6, 8, 12, 13, 15-16, 19-

21, 23-24, 26, 29, 112, 114, 118-125, 128, 131-132, and 135-138.

II. At page 10 of the final Official Action, the Examiner has maintained the rejection of claims 14, 30-33, 36-40, 43-44 and 133 under 35 USC § 103 (a), as being unpatentable over Peck et al. in view of Weiner et al. or Yu et al., respectively, and further in view of Uchikawa et al.

The Examiner asserts that it would have been obvious to the skilled artisan "to combine the teachings of the above references and substitute the exemplified propylene glycol with the instantly claimed glycerol and arrive at the instant invention" because "Uchikawa et al. teach both propylene glycol and glycerol are polyhydric alcohols conventionally used in the art."

In view of the following, this rejection is respectfully traversed.

Claim 14 is indirectly dependent on independent claim 1. Claims 32-33, 36-40 and 43-44 are each directly or indirectly dependent on independent claim 30. Claim 133 is indirectly dependent on independent claim 112. All of claims 1, 30 and 112 specifically exclude encapsulation in a lipid vesicle.

As discussed above in section I incorporated herein in its entirety, present claims 1 and 112 recite the transition language "consisting of." Claim 21 recites providing a pharmaceutical composition "consisting of." This transition language excludes components other than those expressly recited. In addition, claims 1, 21 and 112 have been amended to recite optional specific excipients. Accordingly, claims 1, 21 and 112 clearly exclude encapsulation in lipid vesicles.

Further, none of Peck et al., Weiner et al. or Yu et al., taken alone or

together, teach or suggest a composition having **BOTH** at least 5% minoxidil or a pharmaceutically acceptable salt thereof **AND** less than 10% by weight polyhydric alcohol, as presently claimed.

In addition, Weiner et al. **teach away** from preparing an unencapsulated minoxidil salt formulation. Please see the above discussions in Section I, regarding Peck et al., Weiner et al. and Yu et al., as well as the Hunt Declaration, which arguments are hereby incorporated by reference in their entirety. Again, claims 1 and 112 recite the transition language “consisting of.” Claim 21 recites providing a pharmaceutical composition “consisting of.” In addition, claims 1, 21 and 112 have been amended to recite optional specific excipients. Accordingly, claims 1, 21 and 112 clearly exclude encapsulation in lipid vesicles.

Again, Applicants submit that any suggestion in Yu et al. to employ a minoxidil acid salt, is negated by the disclosure of Weiner et al. in view of the more exhaustive and reliable scientific analysis presented by Weiner et al. and the teaching away from the present claims by Weiner et al. See *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, *Id.* The Examiner is respectfully requested to expressly address this argument should this rejection be maintained.

Applicants submit that Uchikawa et al. do not cure the deficiencies of Peck et al., Weiner et al., and/or Yu et al., because Uchikawa et al. do not teach or suggest a composition having **BOTH** at least 5% minoxidil or a pharmaceutically acceptable salt thereof **AND** less than 10% by weight polyhydric alcohol, as presently claimed.

Further, Uchikawa et al. do not teach or suggest employing a minoxidil acid salt.

In view of the foregoing, it is submitted that nothing in the applied references, taken alone or together, render the claimed invention obvious within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection of pending claims 14, 30-33, 36-40, 43-44, and 133.

III. At page 12 of the final Official Action, the Examiner has maintained the rejection of claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, 26, 112, 118-125, 128, 131-132, and 135-138 under 35 USC § 103 as being unpatentable over JP 07-048230 in view of Weiner et al. or Yu et al. and further in view of Caldini et al.

The Examiner asserts that it would have been obvious to the skilled artisan to combine the teachings of JP 07-048230 ("230") and Weiner et al. or Yu et al. and utilize the instant minoxidil acid salt. The Examiner further asserts that it would have been obvious to the skilled artisan to combine the teachings of the references and utilize benzyl alcohol in the solvent system because Caldini et al. teach that the use of benzyl alcohol improves transcutaneous and transfollicular absorption of active agents.

In view of the following, this rejection is respectfully traversed.

As discussed above in section I incorporated herein by reference in its entirety, present claims 1 and 112 recite the transition language "consisting of." Claim 21 recites providing a pharmaceutical composition "consisting of." This transition language excludes components other than those expressly recited. In

addition, claims 1, 21 and 112 have been amended to recite optional specific excipients. Accordingly, claims 1, 21 and 112 clearly exclude encapsulation in lipid vesicles.

JP '230 describes a hair tonic including 0.1 to 10 g. minoxidil, 30-70 g. ethanol, and water. JP'230, as admitted by the Examiner, does not teach or suggest adding an acid or a co-solvent.

As discussed above, Weiner et al. **teach away** from preparing and/or administering an unencapsulated minoxidil acid salt formulation. The skilled artisan in view of Weiner et al. would have had no motivation to prepare a formulation by employing a minoxidil salt or by reacting minoxidil with an acid to form a minoxidil salt, **absent encapsulation** of the minoxidil salt in a lipid vesicle because Weiner et al. describe that an unencapsulated minoxidil salt exhibits extremely poor penetration. Again, the present claims do not encompass encapsulation in lipid vesicles.

Further, as discussed above, the skilled artisan would have had no motivation to prepare a formulation employing a minoxidil salt or prepare a formulation by reacting minoxidil with an acid to form a minoxidil salt, because Weiner et al. describe that commercial Rogaine® (that is unencapsulated) exhibits significantly greater penetration than exhibited by an unencapsulated minoxidil salt formulation and thus **teach away** from the present claims. Again, the present claims do not encompass encapsulation in lipid vesicles.

Please see the above remarks set forth in Section I, regarding Weiner et al. and Yu et al. incorporated herein by reference in their entirety.

With regard to Yu et al., as discussed above Yu et al. is directed to the use of hydroxyacids to enhance the "therapeutic efficacy of cosmetic and pharmaceutical agents." See col. 2, lines 16-21. Again, Yu et al. is not concerned with and do not even remotely address the problem that the presently claimed subject matter solves, namely, increasing minoxidil amounts while minimizing amounts of propylene glycol, or other polyols. Yu et al. clearly do not describe or suggest the present composition which requires "at least 5% by weight, based on the total weight of the composition, of minoxidil or a pharmaceutically acceptable salt thereof," "an acid in an amount to substantially completely solubilize the minoxidil or a pharmaceutically acceptable salt thereof," and a co-solvent wherein when the co-solvent comprises one or more polyhydric alcohols, the one or more polyhydric alcohols are present in an amount of "less than 10% by weight."

Again, Applicants submit that any suggestion in Yu et al. to employ a minoxidil acid salt, is negated by the disclosure of Weiner et al. in view of the more exhaustive and reliable scientific analysis presented by Weiner et al. and the teaching away from the present claims by Weiner et al. The Examiner is respectfully requested to expressly address this argument should this rejection be maintained.

Prophetic Example 3 of Yu et al. describe a "2% minoxidil" formulation formed by dissolving 2 grams minoxidil and 3 ml lactic acid into a mixture of 80 ml ethanol and 15 ml propylene glycol. A 2% minoxidil formulation contains much less minoxidil than the present compositions which require at least 5% minoxidil. In addition, the formulation of Example 3 of Yu et al. has a large propylene glycol content, i.e., 15%, which amount is substantially greater than the presently claimed "less than 10% by weight."

Regarding Caldini et al., Caldini et al. do not cure the deficiencies of JP 07-048230, Weiner et al., and Yu et al., taken alone or together, because Caldini et al. do not teach or suggest employing a minoxidil acid salt.

In view of the foregoing, it is submitted that nothing in any of JP 07-048230, Weiner et al., Yu et al., and Caldini et al., taken alone or together, suggests the presently claimed subject matter within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection of pending claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, 26, 112, 118-125, 128, 131-132, and 135-138.

IV. At page 14 of the final Official Action, the Examiner has maintained the rejection of claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, and 26-29 under 35 USC § 103 (a), as being unpatentable over Navarro et al. in view of Weiner et al.

The Examiner asserts that it would have been obvious to the skilled artisan "to combine the teachings of Navarro et al. and Weiner and substitute Navarro's cyclodextrin with the instant acid to convert minoxidil into a salt" because "Weiner

teaches that by converting minoxidil to a hydrophilic compound, it penetrates the skin."

Responsive to Applicants arguments, the Examiner asserts that claims 1 and 21 allow for the inclusion of a lipid vesicle or a cyclodextrin carrier because they recite an optional excipient which can be a lipid vesicle or a cyclodextrin carrier. Regarding claim 4, the Examiner asserts that the recited lower limit of *approximately* 7% is considered obvious over Navarro.

In view of the remarks set forth herein, this rejection is respectfully traversed.

As discussed above in section I incorporated herein by reference in its entirety, present claims 1 and 112 recite the transition language "consisting of." Claim 21 recites providing a pharmaceutical composition "consisting of." This transition language excludes components other than those expressly recited. In addition, claims 1, 21 and 112 have been amended to recite optional specific excipients. Accordingly, claims 1, 21 and 112 clearly exclude encapsulation in lipid vesicles and/or in a cyclodextrin carrier.

Claim 4 has been amended to delete the term "approximately."

Navarro et al. describe encapsulating minoxidil in a cyclodextrin carrier, wherein cyclodextrin functions as a "host" molecule to trap the minoxidil "guest" molecule inside the ring. Navarro et al. describe the use of cyclodextrin in order to assist in the solubilization of minoxidil while avoiding high amounts of propylene glycol. Navarro et al. state the following:

[t]he amount of γ -cyclodextrin present in the composition for hair is such that it permits a substantial reduction in the amount of solvent for minoxidil which would normally need to be added to achieve a comparable solubility of minoxidil in the absence of the aforementioned cyclodextrin. (Page 3, lines 9-13 of the English translation).

From the foregoing, it is clear that cyclodextrin is an essential element of Navarro et al. because it must be combined with minoxidil in order to impart improved solubility properties to minoxidil, thereby reducing the amount of solvent such as propylene glycol needed in the formulation. However, the present claims **exclude** cyclodextrin. As such, the encapsulating technique of Navarro et al. is distinguished.

In further support of the foregoing, the Examiners attention is directed to the Declaration submitted previously on November 8, 2007. The Declaration under 37 CFR §1.132 by Albert Zorko Abram ("the Abram Declaration"), was filed in corresponding patent application no. 10/124,197 now US Patent No. 6,946,120, in response to a rejection of the pending claims under 35 USC § 103 as obvious in view of the disclosures of Navarro in view of Weiner et al. and further in view of Leitch.

In the Declaration, Mr. Abram declares in paragraph 9 that supplementing the teaching of Navarro with the teaching of Weiner et al. **would destroy the intended purpose of the Navarro composition**. Mr. Abram declares in paragraph 10 that the role of cyclodextrin in Navarro is to function as a host molecule to trap the minoxidil "guest" molecule inside the ring and that it is the minoxidil-cyclodextrin

"host-guest" complex that imparts improved solubility properties, as compared to a similar minoxidil composition not having cyclodextrin. Mr. Abram declares that it is recognized that cyclodextrins are unstable in acidic conditions and that subjecting cyclodextrins to acidic conditions will result in the degradation of the cyclodextrins into its individual glucose units.

Further, as discussed above and contrary to the Examiners assertion, Weiner et al. **do not** teach or suggest that converting minoxidil to a hydrophilic compound results in improved penetration through the hair follicle. In fact, the data in Weiner et al. clearly illustrates that a minoxidil salt formulation exhibits markedly poorer penetration as compared to the penetration exhibited by commercial Rogaine®. Accordingly, Weiner et al. **teach away** from the preparation/administration of an unencapsulated minoxidil salt formulation. Please see the above discussions in Section I with regard to Weiner et al., incorporated herein by reference in their entirety.

In view of the foregoing, it is submitted that nothing in Navarro et al. and Weiner et al., taken alone or together, renders the claimed invention obvious within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection of pending claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, and 26-29.

V. ***At page 19 of the final Official Action, the Examiner has maintained the rejection of claims 14, 30-33, 36-40, 43-44, 112, 118-125, 128, and 131-138 under 35 USC § 103 (a), as being unpatentable over Navarro et al. in view of Weiner et al. and further in view of Wong et al.***

The Examiner asserts that it would have been obvious to the skilled artisan to combine the teachings of the references and further utilize a propellant because "Wong et al. teach that a propellant allows a solution to aerosolize." The Examiner further asserts that "it would have been obvious to use either propylene glycol or glycerol and arrive at the instant invention."

In view of the remarks set forth herein, this rejection is respectfully traversed.

Claim 14 is indirectly dependent on independent claim 1. Claims 32-33, 36-40 and 43-44 are each directly or indirectly dependent on independent claim 30. Claims 118-125, 128 and 131-138 are each directly or indirectly dependent on independent claim 112. All of claims 1, 30 and 112 specifically exclude encapsulation in a lipid vesicle and/or in a cyclodextrin carrier.

As discussed above in section I incorporated herein by reference in its entirety, present claims 1 and 112 recite the transition language "consisting of." This transition language excludes components other than those expressly recited. In addition, claims 1 and 112 have been amended to recite optional specific excipients. Accordingly, claims 1 and 112 clearly exclude encapsulation in lipid vesicles and/or in a cyclodextrin carrier. Further, claim 30 also clearly excludes encapsulation in lipid vesicles and/or in a cyclodextrin carrier.

As discussed above, Applicants submit that a proper case of *prima facie* obviousness has not been established. Please see the discussions set forth above in Sections I and IV regarding each of Navarro et al. and Weiner et al., which are hereby incorporated herein by reference in their entirety. See also the Abram Declaration.

Applicants submit that Wong et al. do not cure the deficiencies of Navarro et al. and Weiner et al. because Wong et al. also do not teach or suggest employing a minoxidil acid salt let alone a minoxidil acid salt absent encapsulation.

In view of the foregoing, it is submitted that nothing in Navarro et al., Weiner et al., and Wong et al., taken alone or together, renders the claimed invention obvious within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection of pending claims 14, 30-33, 36-40, 43-44, 112, 118-125, 128, and 131-138.

VI. At page 18 of the final Official Action, claims 30-31, 36-40, 43-44, 112, 114, 118-125, 128, 131-132, and 135-138 have been rejected under 35 USC § 103 (a), as being unpatentable over Navarro et al. in view of Weiner et al. and further in view of Peck et al.

The Examiner asserts that it would have been obvious to the skilled artisan "to combine the teaching of the above references and further utilize the instant excipients."

In view of the remarks set forth herein, this rejection is traversed.

Claims 31, 36-40 and 43-44 are each directly or indirectly dependent on independent claim 30. Claims 114, 118-125, 128, 131-132 and 135-138 are each directly or indirectly dependent on independent claim 112. Claims 30 and 112 specifically exclude encapsulation in a lipid vesicle and/or in a cyclodextrin carrier.

Present claims 30 and 112 recite the transition language "consisting of." Please see the discussions set forth above in sections I-V incorporated herein by reference in their entirety. This transition language excludes components other than those expressly recited. In addition, claim 112 has been amended to recite optional specific excipients. Accordingly, claims 30 and 112 clearly exclude encapsulation in lipid vesicles and/or in a cyclodextrin carrier.

As discussed above, Applicants submit that a proper case of *prima facie* obviousness has not been established because there is no motivation to modify Navarro et al. to incorporate the minoxidil acid salt of Weiner et al., let alone an unencapsulated minoxidil acid salt. Please see the discussions set forth above in Sections I, IV and V regarding each of Navarro et al. and Weiner et al. See also the Abram Declaration.

Applicants submit that Peck et al. do not cure the deficiencies of Navarro et al. and Weiner et al. because Peck et al. also do not teach or suggest employing a minoxidil acid salt, let alone an unencapsulated minoxidil acid salt.

In view of the foregoing, it is submitted that nothing in any of the applied references, taken alone or together, suggest the subject matter of claims 30-31, 36-

40, 43-44, 112, 114, 118-125, 128, 131-132, and 135-138 within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

VII. At page 20 of the final Official Action, the Examiner has rejected claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, 26, and 29 under 35 USC § 103 as being unpatentable over Bazzano in view of Weiner or Yu et al.

The Examiner asserts that it would have been obvious to the skilled artisan to combine the teachings of Bazzano and Weiner et al. and utilize the instant minoxidil acid salt. Alternatively, the Examiner asserts that it would have been obvious to combine the teachings of Bazzano and Yu et al. and utilize the instant acid because Yu et al. teach adding lactic acid dissolves minoxidil providing better penetration of minoxidil into the hair follicle.

The Examiner asserts that the claims still allow for the inclusion of a lipid vesicle or a cyclodextrin carrier because they could be considered excipients.

In view of the following, this rejection is respectfully traversed.

Claim 1 recites the transition language "consisting of." Claim 21 recites providing a pharmaceutical composition "consisting of." This transition language excludes components other than those expressly recited. More specifically, the transition language "consisting of" excludes encapsulation in lipid vesicles. In addition, claims 1 and 21 have been amended to recite optional specific excipients.

Accordingly, claims 1 and 21 clearly exclude encapsulation in a lipid vesicle.

With regard to the rejection of the claims as obvious over Bazzano in view of Weiner et al. or Yu et al., it is submitted that a *prima facie* case of obviousness has not been established because the skilled artisan would have no motivation to modify Bazzano to incorporate the minoxidil acid salt of Weiner et al. or Yu et al., let alone an unencapsulated minoxidil acid salt. Please see the above remarks in Sections I-VI regarding each of Weiner et al. and Yu et al., which are incorporated herein by reference in their entirety.

In view of the foregoing, it is submitted that nothing in any of the applied references, taken alone or together, suggest the subject matter of claims 1-4, 6, 8, 12-13, 15-16, 19-21, 23-24, 26, and 29 within the meaning of 35 USC § 103. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

VIII. At page 23 of the final Official Action, the Examiner has rejected claims 1, 21, 30 and 112 under 35 USC § 112, second paragraph.

The Examiner asserts that the claims are indefinite because they are redundant with regard to the recited acids and salts.

Claims 1, 21, 30 and 112 have been amended to delete the recitation of the specific acid. Thus, the claims are not redundant.

In view of the foregoing, it is submitted that claims 1, 21, 30 and 112 are clear and definite within the meaning of 35 USC §112, second paragraph. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

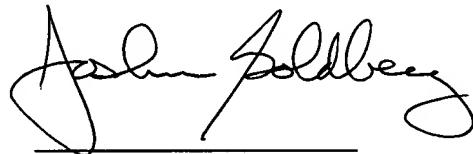
CONCLUSION

Applicants assert that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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